

202-408-4162 to schedule an interview. Applicant's representatives will try to contact the Examiner also, in order that a convenient time for an interview can be determined.

**II. Status of the claims**

Claims 18-53 are pending and stand rejected.

**III. Specification**

The Examiner has maintained the objection to the specification for reasons of record, as stated in the Advisory Action dated March 13, 2002. Applicant respectfully disagrees and reminds the Examiner that if a rejection, or in this case an objection, is maintained in view of Applicant's arguments, the Examiner should take note of Applicant's arguments and answer the substance of them. See M.P.E.P. § 707.07(f). Applicant therefore requests that the Examiner fully address the arguments, should the Examiner choose to maintain the objection.

In particular, as pointed out in the After Final Response dated February 8, 2002, at page 2, lines 6-10, each previous Office Action mistakenly refers back to an amendment filed on April 10, 2000. Such an amendment does not exist. The only amendment Applicant has of record is the Preliminary Amendment filed September 13, 1999. Moreover, Applicant contends that the Preliminary Amendment filed September 13, 1999, did not add "-CO-A-CO-(CH<sub>2</sub>CH<sub>2</sub>)<sub>n</sub>-OH" to the instant specification or any of the claims, as wrongfully asserted by the Examiner. Rather, the Preliminary Amendment merely deleted "-CO-A-CO-O-(CH<sub>2</sub>CH<sub>2</sub>)<sub>n</sub>-OH" for replacement with "-CO-A-CO-O-(CH<sub>2</sub>CH<sub>2</sub>O)<sub>n</sub>-OH" [at page 5, line 22], to correct an obvious error, which is supported by the entire disclosure of the application and by the priority document as originally filed. See M.P.E.P. § 2163.07(II) (obvious errors).

Accordingly, Applicant requests that the Examiner clarify the objection by verifying the inconsistencies in the record, reconsider Applicant's arguments, and withdraw this objection.

**IV. Rejection under 35 U.S.C. § 102(e)**

The Examiner has maintained the rejection of claims 18-29, 35, 36, and 39 under 35 U.S.C. §102(e) over Dupuis et al. (U.S. Patent No. 6,031,043) ("Dupuis") for the reasons set forth in the final Office Action dated October 4, 2001.

Applicant respectfully disagrees and points out that the rejection should be withdrawn, as Dupuis is not available as prior art under §102(e). In particular, Dupuis was filed on March 16, 1998, whereas the present application has an effective U.S. filing date of March 4, 1998, which is prior to the U.S. filing date of Dupuis. See M.P.E.P. § 1893.03(b) (For an international application designating the U.S., the filing date is the PCT international filing date.) See also M.P.E.P. § 1895.01(A) ([t]he U.S. filing date of a national stage application is the international filing date (the filing date of the international application) for the purposes of determining whether information is prior art (i.e., has an effective filing date) relative to the invention claimed in the national stage application.)

Because the filing date of Dupuis is after the filing date of the present application, the rejection is improper, and Applicant therefore respectfully requests that the rejection be withdrawn.

**V. Rejection under 35 U.S.C. § 103**

The Examiner has maintained the rejection of claims 18-53 under 35 U.S.C. §103(a) over O'Neill (U.S. Patent No. 4,300,580) ("O'Neill") in view of Disselbeck et al.

(U.S. Patent No. 5,804,025) ("Disselbeck") further in view of Adams et al. (WO 95/00105) ("Adams"), and Dupuis (U.S. Patent No. 5,830,438) ("Dupuis") for the reasons set forth in the final Office Action dated October 4, 2001. Applicant respectfully traverses this rejection for the reasons of record, as well as for the additional reasons discussed below.

As an initial matter, as emphasized above, if a rejection is maintained in view of Applicant's arguments, the Examiner should take note of Applicant's arguments and answer the substance of them. See M.P.E.P. § 707.07(f). Applicant therefore requests that the Examiner fully address each and every argument, should the Examiner choose to maintain the rejection.

**A. No objective evidence on record to support combination proposed by the Examiner.**

The Federal Circuit has held that there must be a clear and particular suggestion in the prior art to combine the teachings of the cited references in the manner proposed by the Examiner. As explained by the Federal Circuit, "[o]ur case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references." *In re Dembiczak* 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

The Examiner can meet the burden of establishing a prima facie case of obviousness "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to

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combine the relevant teachings of the references.” *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988) (internal citations omitted) (emphasis added).

On January 18, 2002, the Federal Circuit again reaffirmed the Examiner’s high burden to establish a prima facie case of obviousness and emphasized the requirement for specificity. In *In re Sang-Su Lee*, the Federal Circuit held that “[t]he factual inquiry whether to combine references must be thorough and searching. It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with.” 277 F.3d 1338, 1433 (Fed. Cir. 2002). Further, the Federal Circuit explained that

[t]he need for specificity pervades this authority... the examiner can satisfy the burden of showing obviousness of the combination only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.

*Id.* (internal citations and quotation omitted) (emphasis added).

In the present case, Applicant respectfully submits that the requisite objective teaching is not present in the references. In fact, for the reasons emphasized below, the divergent teachings of the references relied on by the Examiner teach away from the combination suggested by the Examiner.

**B. Disselbeck is non-analogous art, and therefore would not have been relied on to overcome the deficiencies of O’Neill.**

“In order to rely on a reference as a basis for rejection of an applicant’s invention, the reference must either be in the field of applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned.”

M.P.E.P. 2141(a) ((citing *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ.2d 1443, 1445

(Fed. Cir. 1992)). In the present case, as discussed in the After Final Response dated February 8, 2002 at page 8, lines 8-15, and in the Response dated August 31, 2001, at pages 10, lines 3-5, Disselbeck does not suggest nor disclose compounds that are useful for topical compositions. Particularly, Disselbeck is directed to high frequency welding, and therefore is not in Applicant's field of endeavor. In fact, Disselbeck explicitly discloses that "[t]he present invention relates to a process wherein selected polyesters are melted incipiently or completely by high frequency welding." Col. 1, lines 7-9.

In view of the above, the Examiner's position that "Disselbeck was used to show that the copolyester of O'Neill could have the same mole percent of the aromatic radical substituent of the instant invention" (Final Office Action at page 4, lines 7-8) completely ignores the fact that one of ordinary skill in the hair care art would not even look to the welding art for guidance on hair care formulations. In particular, different uses of the polyester material would logically lead to different polymer structures with different mole percents. For instance, at column 2, lines 3-10 of Disselbeck, the end products containing the polyester material, which are chemically and conceptually different from hair care compositions, are two and three dimensional shaped structures.

Accordingly, the rejection fails since the polyesters disclosed in Disselbeck, and any percent of aromatic radical substituents that *can be* added to the polyesters disclosed therein, are not reasonably pertinent to the problem of the present invention (e.g., the formation of a topical composition comprising an aqueous gel as recited in claim 18), nor related to O'Neill (i.e., a hair grooming method). Thus, the rejection should be withdrawn for this reason alone.

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**C. Disselbeck and Adams, when viewed as a whole, teach away from the claimed invention.**

As addressed in the Response filed August 31, 2001, at pages 10-11, Disselbeck and Adams, do not overcome the deficiencies of O'Neill. In fact, when viewed as a whole, each reference teaches away from the present invention. See M.P.E.P. § 2141.02 (each "prior art reference as a whole" must be considered) and M.P.E.P. § 2145(X)(D)(1) (a "prior art reference that 'teaches away' from the claimed invention is a significant factor to be considered in determining obviousness"). More specifically, Disselbeck, as discussed above, is completely unrelated to the present invention (i.e., the patent relates to high frequency welding). Adams, on the other hand, is merely concerned with clear hair spray compositions, with no mention of an aqueous gel, as presently claimed. See instant claim 18. Further, Dupuis, a hair care *foam* composition, which the Examiner has relied on to teach propellants, does not cure the deficiencies of Disselbeck or Adams, as Dupuis is not concerned with the hair grooming components O'Neill. (Applicant also points out that Adams discloses the desirable use of *anti-foaming* agents in its formulations, which is contrary to Dupuis. See page 9, lines 23-25.) Accordingly, the rejection should be withdrawn for this additional reason.

**D. The references do not suggest the desirability of their combination.**

Additionally, the references do not suggest the desirability of their combination. See above and M.P.E.P. § 2143.01 ("The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.") (emphasis added.) In particular, O'Neill, when viewed as a whole, teaches that the inventive polyester compound disclosed

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therein more than achieves the desired results of that invention. For instance, O'Neill discloses, with regard to the addition of the polyester formulated by the invention, the "ability to maintain arrangement [of the hair] under conditions simulating those of active persons were all good and at least duplicated those of commercially available grooming compositions . . . [t]he composition has no noticeable odor." Col. 5, lines 16-23 (Examples 2-5). As such, there is no expressed or suggested desirability for modifying O'Neill.

Moreover, none of the other references suggest the desirability of combination with O'Neill (e.g., there is no suggested desirability to combine any of the teachings of a process for high frequency welding with a hair grooming method.) To do otherwise, is improper hindsight reconstruction, simply taking the inventor's specification as a blueprint for piecing together the prior art to defeat patentability is improper. See *In re Dembiczak* at 1614. Furthermore, the Federal Circuit, recently held that "it is improper, in determining whether a person of ordinary skill would have been led to [a] combination of references, simply to use that which the inventor taught against its teacher." *In re Lee* at 1430.

In the present case, it is evident, based on the combination of references used, that the Examiner has merely pieced together Applicant's invention using Applicant's disclosure, which directly contravenes the precedents set forth by the Federal Circuit. Accordingly, the rejection is improper and should be withdrawn for this final reason.

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**Conclusion**

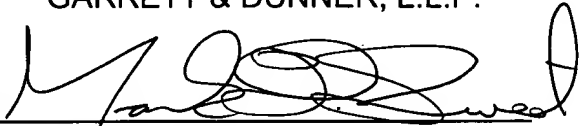
Applicant submits that this claimed invention is not obvious in view of the prior art references cited against this application. Applicant therefore requests the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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By: 

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